

## REMARKS

Claims 1-3 are pending in the application.

Claims 2-3 are withdrawn from consideration.

### Claim Rejections - 35 U.S.C. § 103:

Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Rink (U.S. Patent No. 5,842,265). Applicant respectfully traverses the rejection of claim 1 as being unpatentable over Rink.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)” [MPEP § 2142; 8<sup>th</sup> Edition, Rev. 2, May 2004, Pg. 2100-128].

Rink discloses a process and device for producing bonded plastic/**metal sheets** in the cavity of a modified injection mold. Rink’s process provides a firm frictional bond between the individual metal sheets. In order to join the metal sheets, they are laterally fixed by placing the sheets on top of each other and pressing the sheets against each other followed by injection molding a thermoplastic material

In contrast, the present invention discloses a **metal profile part** comprising two or more **superimposed metal profiles**. The metal profile part in accordance with the

invention comprises a first metal profile and a second metal profile which are connected with each other. Each metal profile has flat edge sections, which extend from both edges of the respective metal profile. The flat edge sections of the metal profiles form contacting surfaces between the metal profiles. Both metal profiles are designed such that the edge sections are lying planar on top of each other when the metal profiles are superimposed. Enclosed openings are provided in each of the edge sections of the two metal profiles. These openings serve for injecting the plastic material so that the metal profiles are connected with each other by means of plastic material parts.

Contrary to the present invention and as discussed in paragraph [0005] of the Background of the Invention section of the instant application, Rink describes a method wherein individual sheets or sheet profiles that are to be connected are inserted in an injection molding tool and are interlockingly connected with each other by pressing or joining by means of a press die. Subsequently, the parts are connected with each other and connected to the formed plastic material part by molding-on a plastic material in the openings in the region of the joining or grouting point and/or in other superimposed openings of the individual sheets. These integrated components, also called hybrid components, however, have the disadvantage of high material costs, since the employed plastic materials, particularly polyamide, are very expensive. Furthermore, they are subject to a comparatively high distortion since the plastic material portion deforms in the integrated component (so-called bimetal effect).

Therefore, Applicant submits that Rink does not provide any teaching or motivation to replace the metal sheets with metal profiles. The process disclosed by Rink can not be used to prepare a metal profile part comprising two or more superimposed metal profiles. Thus, it is submitted that the claimed invention cannot be said to be obvious without some reason given in the prior art, viz. Rink, why one of ordinary skill would have been prompted to modify Rink's teaching to arrive at the claimed invention.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been

obvious, but whether the claimed invention as a whole would have been obvious. *Stratosflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Thus, Applicant submits, that a metal profile part in accordance with the instant invention was contrary to the understandings and expectations of the prior art, and hence it would not have been obvious to those skilled in the art.

Furthermore, the bonded metal sheets in accordance with the process disclosed by Rink are known to be subject to a comparatively high distortion since the plastic material portion deforms in the integrated component.

Thus, Applicant submits that Rink does not provide any disclosure or suggestion to modify the teachings of the prior art to produce the claimed invention. Thus, Applicant submits, that contrary to the Examiner's statement, claim 1 is not a *prima facie* case of obviousness.

Therefore, Applicant believes that claim 1 is allowable, and a holding to this effect is respectfully solicited.

Claim Rejections - 35 U.S.C. § 102:

Claim 1 is rejected under 35 U.S.C. § 102 (b) as being anticipated by Rink (U.S. Patent No. 5,842,265). Applicant respectfully traverses the rejection of claim 1.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 053 (Fed. Cir. 1987).

Applicant respectfully traverses the rejection as being improper. The Examiner is modifying the teaching of the prior art, namely Rink, by equating the metal sheets with

metal profile parts. It is respectfully submitted, that that not all elements of claim 1 are disclosed by the Rink reference, a metal profile part comprising two or more superimposed metal profiles is not disclosed, so the rejection is unsupported by the art and should be withdrawn.

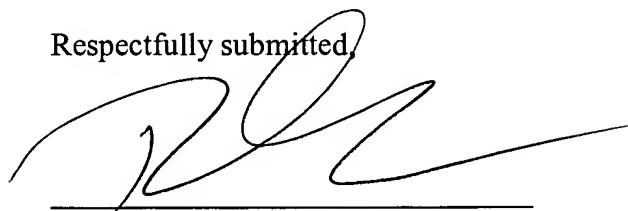
Therefore, Applicant believes that claim 1 is allowable, and a holding to this effect is respectfully solicited.

As such, it is respectfully submitted that claim 1 is in condition for Allowance. Early and favorable reconsideration would be appreciated.

Should the Examiner believe anything further needs to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

As this response has been timely filed within the set period of responses, no petition for extension of time or associated fee is required. However, the Commissioner is hereby authorized to charge any deficiencies in the fees provided, or credit any overpayment to our Deposit Account.

Respectfully submitted,



Robin W. Asher, Reg. No. 41,590  
Clark Hill PLC  
500 Woodward Avenue, Suite 3500  
Detroit, MI 38226-3435  
(313) 965-8300

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